IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Dias et al.	)	Art Unit: 2188
Serial No.: 09/551,745	)	Examiner: Namazi
Filed: April 18, 2000	)	**AM9-98-080C**
For: REAL-TIME SHARED DISK SYSTEM FOR COMPUTER CLUSTERS	)	December 11, 2003 750 B STREET, Suite 3120 San Diego, CA 92101

APPEAL BRIEF

This appeal brief is submitted under 35 U.S.C. §134. This appeal is further to Appellant's Notice of Appeal filed herewith.

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(1) Real Party in Interest

The real party in interest is IBM Corp.

(2) Related Appeals/Interferences

No other appeals or interferences exist which relate to the present application or appeal.

(3) Status of Claims

Claims 1, 3-6, 8, 11-14, 16-18, and 20-22 are pending, and all have been finally rejected except for Claims 5 and 12, which have been indicated as being allowable.

(4) Status of Amendments

No amendments are outstanding.

(5) Summary of Invention

As set forth in Claim 1, the invention is a computer system that has client nodes communicating data access requests to storage nodes. The computer has logic for associating data access requests with respective priorities that include time-based deadlines. The data access requests and priorities are sent to the storage nodes, with the data access requests being ordered at the storage nodes based on the respective priorities. In this way, the data access requests are satisfied in consideration of their respective priorities.

(6) Issue

Whether Claims 1, 3, 4, 6, 8, 11, 13, 14, 16-18, and 20-22 are unpatentable under 35 U.S.C. §103 as being obvious over Harney in view of Chen et al.

(7) Grouping of Claims

The rejected claims are grouped together.

(8) Argument

The rejection alleges that the claims are unpatentable under 35 U.S.C. §103 because it would have been obvious to modify Harney's data request ordering scheme, which is based not at all on temporal

considerations but rather on the bandwidth requirements of various data types, with Chen's deadline-based system.

This immediately begs the question, of course, of why and what in the ***prior art*** suggests gutting Harney's bandwidth-based ordering logic and replacing it with Chen's deadline-based system, since that would obviously defeat the purpose of Harney, which is to respond intelligently to requests based on the bandwidth requirements of particular data types? Plainly, the suggestion cannot come from Harney to obliterate the entire point of its invention. No evidence has been proferred to date that it is common knowledge in the art that bandwidth-based systems like Harney's are interchangeable with time-based systems like Chen et al.'s, so that source for the required suggestion to combine is out, see MPEP §2143. That leaves Chen et al. as the last resort on the record for providing the requisite prior art motivation for the proposed modification of Harney. Unfortunately for the Examiner, Chen et al. nowhere suggests exchanging its deadline-based idea for a bandwidth-based ordering system. Indeed, Chen et al. is directed to a single-disk controller; there is no teaching or suggestion in Chen et al. that it is even scalable to a multi-storage system such as Harney's, much less that its deadline-based ordering scheme is a suitable replacement for the very different bandwidth-balancing ordering scheme of Harney's.

Under the legal standards of patentability, this should be game, set, and match, MPEP §2143.01 (a proposed modification cannot render a reference unsatisfactory for its intended purpose, citing In re Gordon). The Board may be curious at this point about the Examiner's stated rationale for the rejection. According to the rejection.... well, there is no stated rationale. The closest the Examiner approaches to satisfying that most critical element of making a *prima facie* case of patentability - showing where the ***prior art*** offers the motivation to combine references - is in the fourth paragraph of page 4 of the Office. There, it is simply

stated that the proposed combination would be obvious because, well, Chen et al. has a deadline-based request ordering system (first phrase), and that in Chen et al.'s system, more urgent requests are satisfied first (second phrase).

Correct, and congratulations for a nice summary of Chen et al.'s invention. Notably missing, however, is (1) an explanation of why someone would be motivated to remove the inventive aspect of Harney and replace it with a totally different ordering system, and (2) that old Examiner bugaboo, where the ***prior art*** suggests the proposed modification. The rejection plainly is legally deficient and for that reason Appellant respectfully advocates reversal.

In his response on page 2 of the Office Action to Appellant's previous discussion of the deficiency of the *prima facie* case, the Examiner observes that features upon which Appellant relies are not recited in the claims, mentioning that the claims require one or more storages. This completely misapprehends the arguments above. Nowhere has Appellant sought to distinguish Chen et al. on the basis that Chen et al. has only a single storage and the present invention does not. Instead, Appellant's point is that Chen et al. does not appear to suggest that its single-disk system can be scaled up to a system like Harney's, much less that it is an appropriate substitute for Harney's bandwidth-balancing scheme. Appellant's point thus relates to why Chen et al. is not fairly combinable with Harney, not that Appellant claims a multi-disk system and Chen et al. does not.

Page 2 of the Office contains an even more puzzling rebuttal to Appellant's point that it would not have been obvious (and indeed that it would have been illogical) to modify Harney with Chen et al. Specifically, the Examiner waves off Appellant's point using the rather enigmatic explanation that "the fact that applicant has recognized another advantage which would flow naturally from following the suggestion

of the prior art cannot be the basis for patentability". Appellant's entire point is that the proposed combination of references would ***not*** flow naturally from the prior art since the combination results in rendering Harney useless for its intended purpose of balancing bandwidth, thus underscoring the ***absence*** of a prior art suggestion, an absence that glaringly remains in the *prima facie* case and that renders reversal legally appropriate.

Respectfully submitted,

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